REMARKS

This paper is being filed in response to the Office Action dated April 18, 2007.

Claims 1-27, 29-30, and 32-40 remain pending in this application, claim 31 having been canceled in by the present paper, without prejudice, waiver, or disclaimer to the subject matter contained therein. Of the pending claims, claims 35-40 are new and claims 1, 10, 13, 27, 29 and 32 are amended herein. Claims 9, 11, 12, and 16-18 stand allowed, and claims 1-8, 10, 13-15, 19-27, and 29-34 stand rejected. It is not the Applicants' intent to surrender any equivalents because of the amendments or arguments made herein. Reexamination and reconsideration of the application, as amended, are respectfully requested.

Applicants express their appreciation for the allowance of claims 9, 11, 12, and 16-18.

Art-Based Rejections

In paragraph 2, on pages 2-3 of the Office Action, claims 1, 2, 5, 6, 8, 10, 13-15, 24-27, and 29-34 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Wheatley, (US Patent No. 6,386,616) in view of Downey, (US Patent No. 5,522,635). At the bottom of page 3 of the Office Action, claims 3, 19, and 20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Wheatley, (U.S. Patent No. 6,386,616) and Downey, (U.S. Patent No. 5,522,635) in view of Byrd et al., (U.S. Patent No. 4,496,184). Further, on page 4 of the Office Action, claims 4, and 21-23 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Wheatley, (U.S. Patent No. 6,386,616) and Downey, (U.S. Patent No. 5,522,635) in view of Tucker, (U.S. Patent No. 5,261,719). Finally, on pages 4 and 5 of the Office Action, claim 7 was rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Wheatley, (U.S. Patent No. 6,386,616) and Downey, (U.S. Patent No. 5,522,635). The Applicant respectfully submits that the

claims are patentable in light of the clarifying amendments above and the arguments below. Accordingly, the Applicants respectfully traverses the foregoing rejections.

The Wheatley Reference

Wheatley teaches a mechanism for retaining the position of discrete snap fasteners on a tonneau cover rail. The disclosed tonneau cover system includes a plurality of female snap members 32 that are attached along the periphery of a cover 22 and are designed to engage male snap members 30 on rails 24, 26. (*See* Wheatley at Col. 2, lines 45-60.) The male snap members include a protrusion, which engages the frame and creates sufficient force to prevent the snap fasteners from sliding freely along the rail. (*See* Wheatley Abstract.)

Specifically, Wheatley teaches that the male snaps 30 are not freely slideable along the rail 24, 26 but will retain their position unless intentionally moved by an operator. (*See* Wheatly Col. 3, lines 50-53.) The purpose of the novel "nib" 70 in Wheatley is to create "a frictional interference with the rail sufficient to retain the snap portion in its location on the tonneau rail" (*See* Wheatley Col. 2, lines 65-67.) Not only does Wheatley teach snap members that are not freely slideable but Wheatley suggests that the prior art prevented the male snap members from sliding freely along the rail: "One approach to maintaining the male portions on the rail is to use a flexible steel for the base of the male portions so that the male can be crimped or otherwise formed into a C-shape which firmly grips the rail and does not easily slide unless intentionally forced." (*See* Wheatley Col. 1, lines 46-50.)

Irrespective of the requirement that the snaps 30 depend upon intervention in order to change their position with respect to the rail 24, 26 is the fact that the snaps 30 are only movable when not engaged with the cover 22. Wheatley teaches that the addition of the nib 70 is important because a

freely slideable snap member 30 would slide freely out of place as a result of wind, vibration, and other forces when NOT engaged with the cover 22. (*See* Wheatley at Col 1, lines 35-43.) Additionally, the Abstract in Wheatley describes the protrusion 70 as providing a sufficient force to prevent the snap fastener 30 from sliding freely along the rail 24, 26 when the tonneau cover 22 is NOT attached. (*See* Wheatley Abstract.)

The purpose of the adjustability of the male snap members 30 along the rails 24, 26, as taught by Wheatley, is to allow the male snap members 30 to be aligned prior to engagement with female snap members 32 rigidly affixed to tonneau cover 22 but subject to variations. (*See* Wheatley at Col. 1, lines 26-28.) Wheatley teaches the use of a fastening means that requires alignment within a geometric tolerance for successful engagement, and therefore requires adjustability prior to engagement. Wheatley does not teach, suggest, contemplate, or make obvious a fastening means that allows longitudinal movement of the cover with respect to the rail after engagement of the snaps.

The Downey Reference

Downey teaches an apparatus for removably attaching a tonneau cover to a pick-up truck bed. (*See* Downey Abstract.) The apparatus contains frame members 32, 34, 36, and 38 each containing a channel 59 extending the full longitudinal length therein. (*See* Downey Col. 5, lines 14-15.) In addition, the apparatus is made up of four elongated, plastic extrusions slidingly received in the channel of a respective frame member 32, 34, 36 or 38. (*See* Downey Col 5, lines 36-41.) Corner pieces 40 act as stops to prevent any substantial longitudinal movement of extrusion 74 within its respective frame member. (*See* Downey Col. 6, lines 14-17.) A plurality of snap fasteners

96 are used to removably secure the flexible tonneau cover 26 to the extrusions 74. (*See* Downey Col. 6, lines 48-52.)

Downey teaches extrusions 74 that are slidingly inserted during assembly but do not provide slideable functionality thereafter. (*See* Downey Abstract.) Downey specifically dimensions the extrusions 74 to extend the full length of the channels 59 so that the extrusions 74 do not slide: "The channel in the frame member is configured to slidingly receive an elongated, resilient, plastic extrusion which extends the full length of the frame member channel and is secured therein by the frame corner pieces." Downey reiterates this point in the detailed description: "The length of each extrusion 74 is substantially equal to its respective frame member such that each extrusion 74 extends within the full longitudinal length of its respective frame member channel 59." (*See* Downey Col. 5, lines 41-45.) Because the extrusions 74 extend the full length of the channels 59 they can not slide with respect thereto after the corner pieces are assembled. This point is driven home when Downey describes the assembly of the corner pieces 40. Downey makes it specific that once the corner pieces are assembled the extrusions do not slide: "Corner pieces 40 thus act as stops to prevent any substantial longitudinal movement of extrusion 74 within its respective frame member." (*See* Downey Col. 6, lines 15-18.)

Further evidence that the fastening means in Downey does not allow the cover to slide longitudinally with respect to the rail after engagement is given by the object of the invention. The purpose of Downey is to eliminate the requirement of slideable male snap members by providing a snap receiving channel extending substantially the full perimeter. (*See* Downey Col. 2, lines 7-12.) In addition, it can be seen that by attaching the tonneau cover around the full perimeter, as Downey suggests, the longitudinal degrees of freedom have been removed and thus the cover can not slide longitudinally with respect to the rail once assembled.

The Claims are Patentable over the Cited References

Claim 1 of the present invention includes, *inter alia*, "an elongated, substantially rigid second fastening means slideably retained within the channel, the second fastening means having an integrally formed fastening surface positioned to engage the first fastening means; wherein the second fastening means extends along substantially the entire length of the channel and remains slideable along the longitudinal axis of the channel after the first fastening means has engaged the second fastening means, thereby allowing the cover to move relative to the rail."

The cited references do not teach or suggest the above limitations of claim 1 of the present application. Specifically, the cited references do not teach or suggest at least the limitation of the second fastening means extending along substantially the entire length of the channel and remaining slideable along the longitudinal axis of the channel after the first fastening means has engaged the second fastening means, thereby allowing the cover to move relative to the rail.

Although Wheatley teaches a plurality of male snaps 30 that are adjustable with respect to the rail, the plurality of male snaps 30 are not remain slideable along the longitudinal axis of the channel after the female engagement portions 32 has engaged the plurality of male snaps 30. Further, the plurality of male snaps 30 do not permit the tonneau cover (22) to move relative to the rail (24, 26) after engagement as required by claim 1 of the present application.

The Downey reference recites a second fastening means (extrusion 74) that is slidingly engaged during assembly, but makes clear the second fastening means (extrusion 74) does not remain slideable after assembly. Further, the tonneau cover (26) in Downey can not move with respect to the rail (frame members 32, 34, 36, and 38) after engagement, as required by the present invention.

Both Wheatley and Downey are providing a solution to the problem that occurs when using a first fastening means, such as snaps, that requires precise positioning prior to being engaged. Neither Wheatley nor Downey teach, suggest, contemplate, or make obvious the limitation that the second fastening means remains slideable along the longitudinal axis of the channel after the first fastening means has engaged the second fastening means, thereby allowing the cover to move with respect to the rail.

Claim 1 of the present application requires the second fastening means to remain slideable along the longitudinal axis of the channel after the first fastening means has engaged the second fastening means, thereby allowing the cover to move with respect to the rail. The specification in the application supports this limitation: "In particular, the foregoing rail system permits the slat forming the second fastening means to slide forward toward the front wall of the container or truck box and rearward toward the rear wall of the container or truck box a limited amount during use." (*See* paragraph [0015].) Unlike the embodiments in Wheatley and Downey, the present invention suggests a fastening means that does not require precise alignment prior to engagement. The ability to have the cover move with respect to the rail after engagement, not found in Wheatley and Downey, is contemplated for completely different reasons in the present invention. It is desirable that the second fastening means remain slideable and permit the cover to move with respect to the rail to remove wrinkles in the cover material that occur due to premature engagement of the first and second fastening means. (*See* paragraph [0052].) These wrinkles can be removed without detachment thus extending the life of the attachment means. (*See* paragraph [0053].) The cover can be more quickly closed while maintaining a relatively neat and wrinkle-free appearance. (*See* paragraph [0053].) In addition, it permits the tension control assembly to continue to function even

once the fastening means are fully engaged. (*See* paragraph [0053].) As a result, it is believed that a more constant and uniform tension is maintained over the cover. (*See* paragraph [0053].)

Thus, it is submitted that independent claim 1 is patentable over the cited references. Claims 2, 5, 6, and 8 are also patentable over the cited reference, not only because they contain all of the limitations of independent claim 1, but also because claims 2, 5, 6, and 8 describe novel elements and features that are not described in the prior art.

Claim 10 of the present invention includes, *inter alia*, "attaching at least one blocking member to prevent slideable escape of the elongated slat from the side rail, wherein the elongated slat is slideable backwards and forwards along the longitudinal axis of the side rail by an amount of play equal to or greater than 3/16 inches and less than or equal to 1 and ½ inches after the first fastening material has engaged the second fastening material."

The cited references do not teach or suggest the limitations of claim 10. Specifically, the cited references do not teach nor suggest at least the limitation of the elongated slat being slideable backwards and forwards along the longitudinal axis of the side rail by an amount of play equal to or greater than 3/16 inches and less than or equal to 1 and ½ inches after the first fastening material has engaged the second fastening material.

Although Wheatley teaches a plurality of male snaps 30 that are adjustable with respect to the rail, the plurality of male snaps 30 are not slideable backwards and forwards along the longitudinal axis of the side rail after the female engagement portions 32 have engaged the plurality of male snaps 30. Further, Wheatley certainly does not teach or suggest that the plurality of male snaps 30 are longitudinally slideable within the range of greater than or equal to 3/16 inches and less than or equal to 1 and ½ inches as required by claim 10. Wheatley also fails to teach or suggest an elongated slat extending along the longitudinal axis of the side rail as required by claim 10.

The Downey reference recites a second fastening material (extrusion 74) that is slidingly engaged during assembly, but makes it clear that the second fastening material (extrusion 74) does not remain slideable after assembly. Further, the Downey reference does not contain the limitation that the second fastening material (extrusion 74) be restricted to the range of greater than or equal to 3/16 inches and less than or equal to 1 and ½ inches as required by the present invention.

The limitation found in claim 10 that the elongated slat be slideable backwards and forwards along the axis of the side rail after the first fastening means has engaged the second fastening means is further supported by the application and arguments as reasoned for claim 1. The further limitation that the range be equal to or greater than 3/16 inches but less than or equal to 1 and ½ inches is also supported by the specification in the application. (*See* paragraph [0047].) The specification in the application makes clear that if the amount of play is to small the benefits of the invention will not be realized and that if the amount of play is to great a substantial portion of the cover may not be secured to the side rail. (*See* paragraph [0047].) Neither Wheatley nor Downey could have possibly suggested this because a substantial portion of the cover is always unsecured due to the use of snaps.

Claim 13 of the present invention includes, *inter alia*, "a fastening surface capable of reversible attachment to the first fastening means integrated on a surface of the elongated, substantially rigid slat and exposed through the channel, wherein the slat extends along substantially the entire length of the channel and remains slideable along the longitudinal axis of the channel after the first fastening means is attached to the fastening surface thereby allowing the cover to move relative to the rail; and at least one stop attached to the rail limiting the range the slat can slide longitudinally."

The cited references do not teach or suggest the limitations of claim 13 of the present applicaiton. Specifically, the cited references do not teach nor suggest at least the limitation of the

slat extending along substantially the entire length of the channel and remaining slideable along the longitudinal axis of the rail after the first fastening means is attached to the fastening surface thereby allowing the cover to move relative to the rail. Accordingly, claim 13 is patentable over Wheatley in view of Downey for the same reasons that claim 1 is patentable over Wheatley in view of Downey.

Because independent claim 13 is patentable over the cited references, claims 14-15, 24-27, and 29-30 are also patentable over the cited reference, not only because they contain all of the limitations of the independent claim 13, but also because claims 14-15, 24-27, and 29-30 describe novel elements and features that are not described in the prior art.

Claim 32 of the present invention includes, *inter alia*, "an elongated slat slideably contained within the channel; a fastening surface on a surface of the elongated slat and exposed through the channel; and at least one stop limiting the range the slat can slide longitudinally, wherein the elongated slat is slideable backwards and forwards along the longitudinal axis of the channel by an amount of play equal to or greater than 3/16 inches and less than or equal to 1 and ½ inches."

The cited references do not teach nor suggest the limitations of the claim 32 of the present applicaiton. Specifically, the cited references do not teach nor suggest at least the limitation of the elongated slat being slideable backwards and forwards along the longitudinal axis of the channel by an amount of play equal to or greater than 3/16 inches and less than or equal to 1 and ½ inches.

Claim 32 is patentable over Wheatley in view of Downey for the same reasons that claim 10 is patentable over Wheatley in view of Downey.

Because independent claim 32 is patentable over the cited references, claims 32 and 33 are also patentable over the cited reference, not only because they contain all of the limitations of the independent claim, but also because claims 32 and 33 describe novel elements and features that are not described in the prior art.

In paragraph 1, on pages 3-4 of the Office Action, claims 3, 19, and 20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Wheatley, (U.S. Patent No. 6,386,616) and Downey, (U.S. Patent No. 5,522,635) in view of Byrd et al., (U.S. Patent No. 4,496,184). Applicants respectfully traverse.

With respect to the rejection of claims 3, 19 and 20, even if it is assumed that the Examiner is correct that the Byrd et al reference teaches hook and loop fasteners, claims 3, 19, and 20 are still patentable over the combination of Wheatley and Downey with respect to Byrd et al. Neither Wheatley, Downey, nor Byrd et al teach or suggest the limitations noted above with respect to independent claims 1 or 13. Accordingly, claims 3, 19, and 20 are allowable over the combination of Wheatley and Downey in view of Byrd et al. because they contain all of the limitations of independent claim 1 or 13, but also because claims 3, 19, and 20 describe novel elements and features that are not described in the prior art.

In paragraph 2, on page 4 of the Office Action, claims 4, and 21-23 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Wheatley, (U.S. Patent No. 6,386,616) and Downey, (U.S. Patent No. 5,522,635) in view of Tucker, (U.S. Patent No. 5,261,719). Applicants respectfully traverse.

With respect to the rejection of claims 4 and 21-23, because neither Wheatley, Downey, nor Tucker disclose the limitations noted above with regards to independent claims 1 and 13, dependent claims 4 and 21-23 are also patentable over Wheatley and Downey, in view of Tucker. Claims 4 and 21-23 are also allowable over the combination of Wheatley and Downey in view of Tucker because they contain novel elements and features that are not described in the prior art.

In paragraph 3, on pages 4 and 5 of the Office Action, claim 7 was rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Wheatley, (U.S. Patent No. 6,386,616) and Downey, (U.S. Patent No. 5,522,635). Applicants respectfully traverse.

With respect to the rejection of claim 7, because neither Wheatley nor Downey teach or suggest the limitations noted above with regards to independent claim 1, dependent claim 7 is also patentable over Wheatley and Downey. Claim 7 is allowable over the combination of Wheatley and Downey because it contains novel elements and features that are not described in the prior art.

CONCLUSION

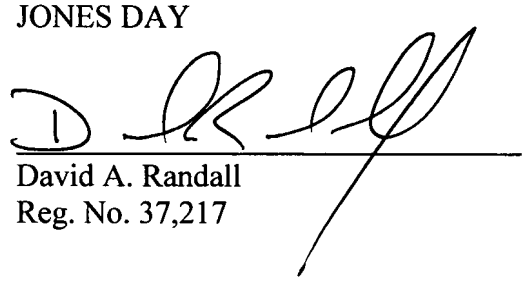
It is submitted that this application is now in good order for allowance and such allowance is respectfully solicited. Should the Examiner believe that there are matters relating to this application remaining that can be resolved in a telephone interview, the Examiner is urged to call the Applicants' undersigned attorney.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at telephone number (213) 489-3939 to discuss the steps necessary for placing the application in condition for allowance.

Respectfully submitted,

JONES DAY

Dated: August 20, 2007

By: 

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